

Application No. 09/841,255

REMARKS

Claim 1-3, 6-9, 12-15 and 23-31 remain for consideration. Claims 1-3, 9, 12-15, 23, 24 and 26 have been amended. Claim 29 is canceled without prejudice to advance prosecution of the application. Claims 1 and 15 have been amended for clarity, and to remove elements of the Markush group. Claims 2, 3, 9, 12-14, 23 and 24 have been amended for consistency with the amendment of claims 1 and 15. Claim 26 has been amended to have a feature of previous claim 29. No new matter has been introduced by the amendments.

Claims 2, 3, 9, 12-14, 23 and 24 have been found free of the art. Claims 1, 6-8, 15 and 25-31 stand rejected. Applicants respectfully request reconsideration of the pending rejection.

Rejection for Obviousness-Type Double Patenting Over 09/136,483

The Examiner provisionally rejected claims 25 under the judicial doctrine of obviousness-type double patenting over claim 9 of copending Application No. 09/136,483. However, while Applicants maintain their position regarding the inappropriateness of this rejection based on the respective filing dates, Applicants have decided to cancel claim 9 of the '483 application. With the filing of this amendment, Applicants have filed a supplemental amendment for the '483 application that cancels claim 9 making this rejection presently moot. Thus, Applicants respectfully request withdrawal of the rejection of claim 25 under the judicial doctrine of obviousness-type double patenting over claims 9 of copending Application No. 09/136,483.

Rejection for Obviousness-Type Double Patenting Over 09/433,202

The Examiner provisionally rejected claims 1, 6, 15, 25, 26, 29 and 31 under the judicial doctrine of obviousness-type double patenting over claims 1, 3, 24 and 26 of copending Application No. 09/433,202. Applicants strenuously maintain that the rejection for obviousness-

Application No. 09/841,255

type double patenting over a later filed application is not appropriate. In particular, Applicants refer the Examiner to Official Gazette Notice 1202 OG 112 (September 30, 1997) for support for the proposition that MPEP 804.02VI only applies to related cases claiming priority benefits under 35 U.S.C. § 120, 121 or 365(c). However, the original claims of the '202 have been canceled, and new claims substituted for these. The present claims above are not obvious over the current claims of the '202 application. In view of the cancellation of the claims of the '202 application, Applicants respectfully request withdrawal of the rejection of claims 1, 6, 15, 25, 26, 29 and 31 under the judicial doctrine of obviousness-type double patenting over claims 1, 3, 24 and 26 of copending Application No. 09/433,202.

Rejection Over U.S. 4,842,837

The Examiner rejected claims 26, 29 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,842,837 to Shimizu. Applicants maintain that the previous claims are free of the disclosure in this reference. However, to advance prosecution of this application, Applicants have amended claim 26. In view of the amendment to claim 26, the Shimizu patent clearly does not render Applicants' claimed invention *prima facie* anticipated. Thus, Applicants respectfully request withdrawal of the rejection of claims 26, 29 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,842,837 to Shimizu.

Rejection Over U.S. 4,842,837, U.S. 5,318,927, U.S. 5,626,715 and U.S. 5,389,194

The Examiner rejected claims 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of U.S. 5,318,927 to Sandhu, U.S. Patent 5,626,715 to Rostoker et al. and U.S. Patent 5,389,194 to Rostoker. Claims 27 and 28 depend from claim 26. To advance prosecution of the application, Applicants have amended claim 26. In view of the amendments, the combined disclosures of the cited references do not render claims 27 and 28 *prima facie*

Application No. 09/841,255

obvious. Applicants respectfully request withdrawal of the rejection of claims 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of U.S. 5,318,927 to Sandhu, U.S. Patent 5,626,715 to Rostoker et al. and U.S. Patent 5,389,194 to Rostoker.

Rejection Over U.S. 5,389,194 or U.S. 5,626,715

The Examiner rejected claims 6-8, 25-27 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,389,194 to Rostoker or under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,626,715 to Rostoker et al. Applicants incorporate by reference their arguments from their Appeal Brief of February 10, 2004 and their Reply Brief of May 17, 2004. Applicants maintain that the Examiner has failed to establish *prima facie* anticipation. Applicants respectfully request reconsideration of the rejection based on the following comments.

"Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131. "Here, as well, anticipation is **not** shown by a prior art disclosure which is only '**substantially the same**' as the claimed invention." Jamesbury Corp. v. Litton Industrial Products, Inc., 225 USPQ 253, 256 (Fed. Cir. 1985)(emphasis added).

The Examiner is giving meaning to the terms in the Examples that are not found in the text. The prophetic examples of the Rostoker patents only give values for X, Y or Q, and Z. The Rostoker patents clearly do not say in any way that all of their particles are within a certain cutoff value. Applicants have presented evidence that a method of producing the particles with the claimed distribution of particle sizes was not known in the art. This evidence was in the form of a Declaration of Dr. Kambe, an expert in the field. Dr. Kambe is widely recognized as one of

Application No. 09/841,255

the top experts in the world. This evidence has not been refuted by the Patent Office. The Federal Circuit has indicated that the Patent Office must consider the Kambe Declaration. See, *In re Kumar*, 418 F.3d 1361, 1368, 1369 (Fed. Cir. 2005).

With all due respect, the Examiner asserts mysteriously that Professor Singh "did understand the references." However, the Singh Declaration stated that the discussion in the Rostoker patents "had several inconsistencies." The Declaration goes on to discuss various alternative interpretations and why these are not satisfactory from a consistency view point. Somehow, the discussion of inconsistencies is now interpreted as clarity. The Examiner has not presented any documentary evidence of any kind that lends support to any interpretation of the language in the Rostoker patents.

Applicants respectfully assert that the Examiner has failed to establish *prima facie* anticipation, and to the extent that *prima facie* anticipation has been established, this has been rebutted. Applicants respectfully request withdrawal of the rejection of claims 6-8, 25-27 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,389,194 to Rostoker or under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,626,715 to Rostoker et al.

Rejection Over U.S. 5,389,194 or U.S. 5,626,715 in View of U.S. 5,318,927

The Examiner rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,389,194 to Rostoker or U.S. 5,626,715 to Rostoker et al. in view of U.S. 5,318,927 to Sandhu. Claim 28 depends from claim 26. To advance prosecution of the present application, Applicants have amended claim 26. In view of the amendment of claim 26, the combined teachings of the disclosures of the cited references clearly do not render claim 28 *prima facie* obvious. Applicants respectfully request withdrawal of the rejection of claim 28 under 35 U.S.C. § 103(a) as being unpatentable over U. S. 5,389,194 to Rostoker or U.S. 5,626,715 to Rostoker et al. in view of U.S. 5,318,927 to Sandhu.

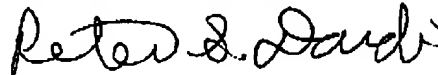
Application No. 09/841,255

CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.
Registration No. 39,650

Customer No. 62274
Dardi & Associates, PLLC
U.S. Bank Plaza, Suite 2000
220 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (404) 949-5730